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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/973,365	10/09/2001	James F. McGuckin JR.	1204	5931
7590	01/23/2004		EXAMINER	
Neil D. Gershon Rex Medical Suite 2 2023 Summer St. Stamford, CT 06905			NGUYEN, VI X	
			ART UNIT	PAPER NUMBER
			3731	
			DATE MAILED: 01/23/2004	

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/973,365

Applicant(s)

MCGUCKIN ET AL.

Examiner

Victor X Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 December 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,8,9,13,16-19 and 23-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,8,9,13,16-19 and 23-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4,5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

1. This application contains claims 2-7, 10-12, 14-15 and 20-22 drawn to non-elected inventions. In Paper No. 8, dated 12/10/2003, applicant elected to prosecute the species of Figs 18-21B. However, it would appear that claims 1, 8-9, 13, 16-19 and 23-28 relate to Species of figs 18-20. Claims 2-7, 10-12, 14-15 and 20-22 do not read upon the elected species.

The requirement is still deemed proper and is therefore made **Final**.

The status of claims 2-7, 10-12, 14-15 and 20-22 have been canceled in Paper No. 8 of the remarks section. However in the last response, applicant stated that claims 2-7, 10-12, 14-15 and 20-22 were withdrawn. Clarification is requested.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 16-17 and 24-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 16 recites “wherein the main and branch portions include a longitudinally extending spine--”) is unclear. It should be changed to “wherein the main and branch portions **each** include a longitudinally extending spine—“.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 8-9, 13, 16, 18-19, 23-24 and 28 are rejected under 35 U.S.C. 102 (b) as being anticipated by Penn et al (U.S. 5,906,640).

Penn et al disclose in figs 15-18, a system having all the limitations of claims 1, 8-9, 13 and 19, including: a stent portion (100) has a main portion (103) and a branch portion (105). The main portion has an intermediate portion (107). The first (108) and second stents (see col. 4, lines 12-60) are positioned within the main and branch portions, so the main and branch portions expand upon expansion of their respective stents. The branch portion is integral with the main portion (103).

Regarding claims 16, 18 and 28, Penn et al disclose the main portion (103) and a branch portion (105) include an extending spine (111) and a plurality of ribs (figs 11 and 18) extending from the spine.

Regarding claims 23-24, Penn et al disclose the first and second stents are formed from a laser cut tube (see col. 5, lines 15-25).

Claims 1, 8, 16-19, 26 and 28 are rejected under 35 U.S.C. 102 (e) as being anticipated by Wilson et al (U.S. 6,264,682).

Wilson et al disclose in figs 14, 18, col. 3, lines 44-67 and col. 4, lines 1-54, a system having all the limitations of claims 1, 8, 16-19, 26 and 28, including: a stent portion (10) has a

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main portion (5) and a branch portion. The main portion has an intermediate portion (see col. 18, lines 1-14). The first (5) and second stents (20) are positioned within the main and branch portions, so the main and branch portions expand upon expansion of their respective stents. The branch portion is integral with the main portion (5).

Regarding claims 16, 18 and 28, Wilson et al disclose the main portion (5) and a branch portion include an extending spine and a plurality of ribs (fig. 14) extending from the spine.

Regarding claims 17 and 26-27, Wilson et al disclose the ribs terminate at first and the second tips that interleave with first and second tips of adjacent ribs (see fig. 14).

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 25-26 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Wilson et al (6,264,682)

Regarding claims 25-26, Wilson et al disclose substantially limitations as recited in the claim, except for each of the ribs forms a c-shape. It would have been obvious matter of design choice to one skilled in the art at the time the invention was made to construct the ribs of Wilson et al device with the ribs form a c-shape, since applicant has not disclosed that doing so which solves any stated problem or is anything more than one of numerous shapes or configurations a

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person ordinary skill in the art would find obvious for the purpose of providing with a different ribs structure. In re Dailey and Eilers, 149 USPQ 47 (1966).

***Conclusion***

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Pat. No. 4,994,071 to MacGregor

U.S. Pat. No. 6,409,750 to Hyodoh

U.S. Pat. No. 6,514,281 to Blaeser

U.S. Pat. No. 5,632,771 to Boatman

U.S. Pat. No. 5,669,924 to Shaknovich

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor X Nguyen whose telephone number is (703) 305-4898.


The examiner can normally be reached on M-F (8-4.30 P.M).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Milano can be reached on (703) 308-2496. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

Victor X Nguyen  
Examiner  
Art Unit 3731

Vn *VP*  
January 02, 2004

  
MICHAEL J. MILANO  
SUPERVISORY PATENT EXAMINER  
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